

08CU5777-2

REMARKS

Claims 1-56 are pending in the present application. Reconsideration and allowance of the claims is respectfully requested in view of the following remarks.

Upon review of the file Applicants noted that two Information Disclosure Statements, filed on December 17, 2002 and July 17, 2001 apparently have not been considered as the Applicants have not received an initialed copy. Applicants respectfully request rectification.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-9, 12-31, 34-43, and 46-50 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by EP 921 161. Applicants respectfully traverse this rejection.

EP 921 161 discloses a composition comprising a polyetherimide resin, an aromatic polycarbonate resin, and a functionalized polysiloxane polymer (Col. 1, lines 30-36). This European Patent Application incorporates three patent applications by reference in paragraph [0023]. The Examiner has relied upon this incorporation by reference to assert that EP 921 161 discloses the use of a polycarbonate ester. Applicants earnestly disagree. Incorporation by reference is permissible in U.S. Patent Applications but is not proper in a European Application and not given any weight with regard to enablement. Thus Applicant's assert that an Examiner may not employ the teachings of a reference incorporated by reference in a European Application in a rejection under 35 U.S.C. § 102(b) particularly when the incorporated reference is being relied upon to supply essential elements of the claim.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Variet Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Applicants respectfully assert that EP 921 161 alone does not disclose polycarbonate esters and hence does not anticipate the pending claims.

Additionally, Applicants note that the instant claims are directed to a composition and method of making the composition comprising a polydiorganosiloxane having a nominal weight average molecular weight of from about 100,000 to about 1,500,000 grams/mole. EP 921 161, in its broadest teaching with regard to polysiloxane molecular weight teaches a polysiloxane having a weight average molecular weight greater than about 1,500 g/mol (paragraph [0029]). EP 921 161 goes on to teach a preference for polysiloxanes having a

08CU5777-2

molecular weight of 1,500 to 30,000 g/mol. A molecular weight of 100,000 g/mol is more than 66 times larger than a molecular weight of 100,000 g/mol. Applicants assert that a teaching of a polysiloxane having a molecular weight greater than 1500 g/mol lacks sufficient specificity (MPEP 2131.03) to anticipate a claim requiring a polydiorganosiloxane having a minimum molecular weight of 100,000 grams/mol.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 43 and 44 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over EP 921 161. Applicants respectfully traverse this rejection.

As discussed above, EP 921 161 does not teach with sufficient specificity a composition comprising a polydiorganosiloxane having a molecular weight of 100,000 to 150,000 g/mol. Because EP 921 161 does not teach a composition comprising a composition comprising a polydiorganosiloxane having a molecular weight of 100,000 to 150,000 g/mol, EP 921 161 cannot teach or suggest a method of making a composition as is instantly claimed.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996). Because EP 921 161 does not disclose use of a polydiorganosiloxane having a molecular weight of 100,000 to 150,000 g/mol with sufficient specificity EP 921 161 does not disclose all elements of the claimed invention and cannot provide adequate basis for a *prima facie* case of obviousness.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants.

08CU5777-2

Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise,
please charge them to Deposit Account No. 07-0862 maintained by Assignee.

Respectfully submitted,

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